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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,460	11/20/2003	Frederick James Diggle III	BE1-0015US	9858
49584	7590	07/18/2005		
LEE & HAYES, PLLC 421 W. RIVERSIDE AVE. SUITE 500 SPOKANE, WA 99201			EXAMINER PETERSON, KENNETH E	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

TAL

Office Action Summary	Application No. 10/718,460	Applicant(s) DIGGLE ET AL.	
	Examiner Kenneth E. Peterson	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 13-23 is/are pending in the application.
- 4a) Of the above claim(s) 7,8,15,16 and 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,9,10,13,14,17,21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3,5,6,13,14,17 and 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Lyman '571, who shows a body (10) having the recited three surfaces, and a stabilizer having a first portion (left 24) that contacts the workpiece, a second portion (28) that is spaced from the workpiece, and a third portion (right 24) contacting the workpiece. Examiner notes that the courts have ruled that the term "integral" covers objects that have multiple pieces solidly fixed together.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6,9,10,13,14,17 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lyman '571.

In regards to at least claim 9, Lyman's body member is not made of plastic. Examiner takes Official Notice that in the art of pipe cutting, it is well known for the curved pipe positioner to be made from plastic. An example of this is the patent to Weaver '781 (note the cross-hatching in figures 5,6,9 and 11). Additional examples can

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be provided if needed. It would have been obvious to one of ordinary skill in the art to have made the body member out of plastic, as is well known and shown by Weaver, in order to manufacture the device more cheaply.

In regards to at least claim 4, it is assumed that Applicant meant to say "parallel" and not "coplanar". Coplanar means "lying in the same plane", which is not the case with Applicant's first and second surfaces (they lie in spaced, parallel planes). Lyman's first and second surfaces are not parallel. Examiner takes Official Notice that it is a known variation for these two surfaces to be parallel. An example of this is the patent to Weaver '781 (see figures 1 and 2, at 14 and 18). In fact, the orientation of the first surface is of no importance to the operation of the device. Nonetheless, It would have been obvious to one of ordinary skill in the art to have made the first and second surfaces parallel, as is well known and shown by Weaver, since they are art-recognized equivalents known for the same purpose. See MPEP 2144.06.

In regards to at least claim 17, if one were to improperly interpret the term "integral" to mean "cast as one piece". Then examiner notes that the courts have long ruled that it is obvious to make intergral that which used to come in pieces. In In re Lockhart, 90 USPQ 214, the court ruled that "It appears to us that the unity or diversity of parts would depend more upon the choice of the manufacturer, and the convenience and availability of the machines and tools.....than on any inventive concept". Furthermore, Examiner takes Official Notice that it is well known to form an entire saw guide as one integral piece. An example of this is the patent to Weaver '781 (figure 1). Additional patents can be provided if needed. It would have been obvious to one of

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ordinary skill in the art to have formed Lyman's device as one integral piece, as is well known, as is taught by Weaver, and as ruled by the courts, in order to simplify manufacture of it.

In regards to at least claim 10, Lyman's body member is not elastic. Examiner takes Official Notice that it is old and well known for pipe positioners to elastically snap around the pipes to position them for cutting. An example of this is the patent to Kooiman '963. Additional examples can be provided if needed. It would have been obvious to one of ordinary skill in the art to have made Lyman's body elastic and extended the side to snap around the pipe, as is well known and taught by Kooiman, in order to be able to better grip and position the pipe being cut.

5. Applicant's arguments have been fully considered but they are not persuasive.

Applicant has overcome the objection to the drawings.

Applicant has successfully overcome the Kooiman and Hall rejections under 102b.

Applicant's arguments against the Lyman reference were unpersuasive.

Applicant argues that Lyman's body member is perpendicular to the first portion of the stabilizer member. However, Lyman does meet the limitation of "a first portion connected to the body member in parallel relation thereto", because it is parallel to the surface to which it connects. Examiner notes that Applicant's own body member has an extent that is perpendicular to first portion of the stabilizer member.

Applicant further argues that the opposed ends of Lyman's first and third stabilizer portions are not configured to contact the workpiece. The "ends" are considered to be the leg portions of the U-shaped pieces (24). The insides of the legs contact the pipe, and thus the "ends" are contacting the pipe. Also, the question arises about the shape of the pipe. Since the pipe itself is not part of the claimed apparatus, it need not be round, but could be most any cross-section, which would have different portions touching different parts of the stabilizer.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Peterson whose telephone number is 571-272-4512. The examiner can normally be reached on Monday thru Thursday between 7:30am and 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached at 571-272-4514. In lieu of mailing, Applicants are encouraged to fax responses to 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. For more info on the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

kp
13-Jul-05


KENNETH E. PETERSON
PRIMARY EXAMINER